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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,366	01/22/2002	James W. Cooper	YOR9-2001-0647US1	8382
29683	7590	12/12/2005	EXAMINER	
HARRINGTON & SMITH, LLP 4 RESEARCH DRIVE SHELTON, CT 06484-6212			BETIT, JACOB F	
			ART UNIT	PAPER NUMBER
			2164	
DATE MAILED: 12/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,366

Applicant(s)

COOPER ET AL.

Examiner

Jacob F. Betit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application on 03-October-2005 after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06-September-2005 has been entered.

Remarks

The currently presented claims 21 and 22 appear to keep markings from previously presented amendments to these claims (i.e. "document.-" in line 4 of claim 21 and "-for" in line 4 of claim 22). The next office action should include a listing of the claims that corrects these minor informalities.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Claims 1, 8-10, 16, and 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: steps indicating what documents (i.e. smallest / largest) the comparing step should start operating on and what documents the method should stop operating on. It is not clear if the method is only operated on two documents (i.e. "first document" and "second document"). It is also unclear what would happen if "a given document" was the largest document. It appears that in this case the claim would not be functional.

5. Claims 1, 16, and 31 recite the limitation "the step of comparing compares a given document with next larger-documents in the document list". This renders the claim indefinite because it contradicts the earlier recited limitation of the comparing step, which states, "comparing the list of salient terms for a first document to the list of salient terms for a second document".

Claims 2-7 and 17-22 are rejected for being dependent on rejected independent claims 1 and 16 respectively.

6. The term "about 90%" in claims 2 and 17 is a relative term which renders the claims indefinite. The term "about 90%" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is impossible for one of ordinary skill in the art to determine how close to 90% of the terms must be found in each of the lists.

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7. Claims 8 and 23 recite the limitation “the step of comparing compares a given document with next larger-documents in the document list”. This renders the claim indefinite because it contradicts the earlier recited limitation of the comparing step, which states, “comparing the list of terms for a first document to the list of terms for a second document”.

8. Claims 9 and 24 recite the limitation “the step of comparing compares a given document only with another document in the list that is no more than a predetermined amount larger than the given document”. This renders the claim indefinite because it contradicts the earlier recited limitation of the comparing step, which states, “comparing the list of terms for a first document to the list of terms for a second document”.

9. Claims 10, 25 and 32 recite the limitation “the step of comparing compares a given document with the next larger-documents in the document list”. This renders the claim indefinite because it contradicts the earlier recited limitation of the comparing step, which states, “comparing the document signature for each document from the list of salient terms obtained for the document”.

Claims 11-15, 26-30, and 33 are rejected for being dependent on rejected independent claims 10, 25, and 32 respectively.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claim 16-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Gomes et al.

(U.S. patent No. 6,615,209 B1)

As to claim 16, Gomes et al. teaches a system for processing data representing documents comprising, for individual documents of a set of documents,

a processor (see figure 13, reference number 1310)

for executing a software program to obtain a list of salient terms found in each document and for comparing the list of salient terms for a first document to the list of salient terms for a second document, said processor being operable for declaring the first document to be substantially identical to, or substantially similar to, the second document if some predetermined number of terms are found in each of the lists of the first document and the second document, wherein the step of comparing includes a preliminary step of sorting the documents into a document list in order of increasing size, and where the step of comparing compares a given document with the next larger documents in the document list. (According to M.P.E.P. section 2106:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

(A) statements of intended use or field of use,

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- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

This list of examples is not intended to be exhaustive.

In this case these structures of the claim appear to be optionally recited or recited as intended use. These limitations of the claim appear to be instructions the processor is capable of performing or has the ability to perform but does not actually have to perform. The claim limitations are not recited in a way so as to require that these steps be performed. For example, one limitation states “for (capable of or intended to be used for) executing a software program to obtain a list of terms found in each document”). The claim should be amended so that the steps are required to be performed either by amending the claim to positively recite the steps (i.e. “a processor that executes a software program to obtain a list of terms found in each document”) or use means plus function language to define the systems characteristics (i.e. “means for executing a software program to obtain a list of terms found in each document”).

Claims 17-18 and 22 are rejected because they recite additional steps to optionally recited limitations, and are not necessarily required by the structure of the claimed system.

As to claim 19, Gomes et al. teaches further comprising a memory containing a database (column 7, lines 13-27, where “a memory containing a database” is read on “an in-memory hash table”) for storing the lists of salient terms.

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As to claim 20, Gomes et al. teaches said processor being further operable (see figure 13, reference number 1310 and see column 13, lines 51-60) for computing a signature for each document, and further comprising a memory (see figure 13, reference number 1320) for storing the computed document signature in association with the list of salient terms for each document.

As to claim 21, Gomes et al. teaches said processor being further operable for computing a signature for each document, and further comprising a memory (see figure 13, reference number 1320) for storing the computed document signature in association with the list of salient terms for each document.

As to claim 23, Gomes et al. teaches a system for processing data representing documents comprising, for individual documents of a set of documents,

a processor (see figure 13, reference number 1310)

for executing a software program to obtain a list of terms found in each document and for comparing the list of salient terms for a first document to the list of terms for a second document, said processor being operable for declaring the first document to be substantially identical to, or substantially similar to, the second document if some predetermined number of terms are found in each of the lists of the first document and the second document, wherein said processor is further operable, before comparing the lists of terms, to sort the documents into a document list in order of increasing size, and to then compare a given document with the next larger documents in the document list (These structures of the claim appear to be optionally recited or

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recited as intended use).

As to claim 24, Gomes et al. teaches a system for processing data representing documents comprising, for individual documents of a set of documents,

a processor (see figure 13, reference number 1310)

for executing a software program to obtain a list of terms found in each document and for comparing the list of salient terms for a first document to the list of terms for a second document, said processor being operable for declaring the first document to be substantially identical to, or substantially similar to, the second document if some predetermined number of terms are found in each of the lists of the first document and the second document, wherein said processor is further operable, before comparing the lists of terms, to sort the documents into a document list in order of increasing size, and to then compare a given document only with another document in the list that is no more than a predetermined amount larger than the given document (These limitations of the claim appear to be optionally recited or recited as intended use).

As to claim 25, Gomes et al. teaches a system for processing data representing documents, comprising, for individual documents of a set of documents,

a processor

for executing a software program to obtain a list of terms found in each document, for computing a document signature for each document from the list of terms obtained for the

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document; for comparing the document signature for a first document to the document signature for a second document; and for declaring the first document to be substantially identical to the second document if the document signatures are equal, wherein said comparing includes sorting the documents into a document list in order of increasing size, and where said comparing compares a given document with the next larger-documents in the document list (These limitations of the claim appear to be optionally recited or recited as intended use).

Claims 26-28 are rejected because they recite additional steps to optionally recited limitations, and are not necessarily required by the structure of the claimed system.

As to claim 29, Gomes et al. teaches and further comprising a memory containing a database for storing the computed document signatures (column 7, lines 13-27, where “a memory containing a database” is read on “an in-memory hash table”).

Claim 30 is rejected because it recites additional steps to optionally recited limitations, and is not necessarily required by the structure of the claimed system.

Allowable Subject Matter

-  12. Claims 1, 8-10, , and 31-32 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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13. Claims 2-7, 11-15, and 33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments with respect to claims 1-7, 16-22 and 31 have been considered but are moot in view of the new ground(s) of rejection and the interpretation given to claims 16-22 that is discussed above.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob F. Betit whose telephone number is (571) 272-4075. The examiner can normally be reached on Monday through Friday 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

jfb
6 Dec 2005


SAM RIMELL
PRIMARY EXAMINER